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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,556	10/17/2001	Arnold G. Slezak	P1535US01	6786
7590	11/15/2010		EXAMINER	
Fellers, Snider, et al Bank One Tower 100 N. Broadway, Ste. 1700 Oklahoma City, OK 73102-8820			TUGBANG, ANTHONY D	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/981,556	<b>Applicant(s)</b> SLEZAK, ARNOLD G.
	<b>Examiner</b> A. Dexter Tugbang	<b>Art Unit</b> 3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

1) Responsive to communication(s) filed on 07 July 2010.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3 and 5-33 is/are pending in the application.

4a) Of the above claim(s) 10-20 and 25-33 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3,5-9 and 21-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SCE/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Pre-Appeal Brief Review***

A Pre-Appeal Review was conducted by a panel of conferees, the results of which were mailed to the applicant(s) on July 7, 2010. It is well worth noting that during this review, the panel had agreed with the examiner's rejections under 35 U.S.C. 112, first and second paragraphs, as applied in the last Office Action (mailed on February 24, 2010), as well as the examiner's arguments being sound in support of the rejections. However, the panel also noted that the prior art, particularly Kuroba et al., should be reapplied to Claim 1, as noted below. Accordingly, prosecution is hereby reopened.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

**Claims 10 through 20 and 25 through 33 continue to stand as being withdrawn from further consideration pursuant to 37 CFR 1.142(b)**, as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the replies filed on May 31, 2005 and June 18, 2004.

### ***Claim Rejections - 35 USC § 112***

**Claims 1, 3, 5 through 9, and 21 through 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claim 1, the recitation of "the prewritten discs placed around the motor hub with respect to each other so that the alignment axes amount the plurality of prewritten discs are angularly disposed symmetrically around the motor hub" (lines 6-9) is new matter. The specification and drawings, as originally filed, provide no written description of any alignment axes of the prewritten discs being angularly disposed *symmetrically* around the motor hub. The specification, as originally filed, does not even use the terms of "angularly disposed" or "symmetrically".

**Claims 1, 3, 5 through 9 and 21 through 24, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In Claim 1, it is unclear from the disclosure what is meant by the phrase of "a direction of an alignment axis...symmetrically around the motor hub" (lines 3-9).

A person having ordinary skill in the art would not understand what is claimed when the claims are read in light of the specification. The claims recite the prewritten discs have servo tracks that are "are offset in a direction of an alignment axis that is in the same angular direction for all of the plurality of prewritten discs" and the discs are placed "so that the alignment axes among the plurality of prewritten discs are angularly disposed symmetrically around" the motor hub.

The specification describes a process of locating an alignment mark on a prewritten disc and rotating and aligning the prewritten disc with a biasing force in a direction toward the center

of the disc. The specification does not describe the applicant(s) invention in terms of an "alignment axis that is in the same angular direction for all of the plurality of prewritten discs" and "discs are placed so that the alignment axes among the plurality of prewritten discs are angularly disposed symmetrically around the motor hub". A person of ordinary skill in the art would not understand what *alignment axis* is being referred to. For example, angular directions for the discs can occur into and out of the page (of Figure 2). Therefore, it would be impossible to determine an alignment axis that would be the very same angular direction for all of the discs in a plane into and out of the page (of Figure 2). Accordingly, the claims terms are not sufficiently described in the specification and the meaning of the claims is undeterminable, subject to plural interpretations, and therefore indefinite.

***Claim Rejections - 35 USC § 102***

**Claims 1, 3, 5 through 7 and 9, as best understood, are rejected under 35**

**U.S.C. 102(b) as being anticipated by Kuroba et al 6,081,990.**

Kuroba discloses a method comprising: placing a plurality of prewritten discs 20, each prewritten disc having servo tracks characterized by a concentricity offset in a direction of an alignment axis that is the same angular direction for all of the plurality of the prewritten discs in relation to a center of the respective prewritten disc, around a motor hub (spindle 21), the prewritten discs placed around the motor hub with respect to each other so that the alignment axes among the prewritten discs are angularly disposed symmetrically around the motor hub (col. 8, lines 31+); and after the placing step, biasing each of the plurality of prewritten discs in a direction of the respectively alignment axis to concentrically align the servo tracks of a first disc

of the plurality of prewritten discs with the servo tracks of a second disc of the plurality of prewritten discs (see various embodiments of Figures 1a, 4, 7a, 7b, 8a and 8c).

The term “biasing” is read as the effect of balancing the disc, or movement of the disc, necessary for balancing the discs on the hub during assembly of the disc drive (see col. 8, lines 31+). The claimed “alignment axis” can be read as an axis line either perpendicular to each disc through reference marker 22, or at some angle (i.e. into and out of the page of Figure 4) from the disc surface drawn through the reference marker 22.

Regarding Claim(s) 7, Kuroba further teaches a reference mark 22 that can be read as the “indicia”

Regarding Claim(s) 3, Kuroba further teaches that biasing includes pressingly engaging each disc, which would include an edge of each disc against the motor hub.

Regarding Claim(s) 5, in Kuroba if the alignment axis is drawn at some angle from the disc surface (into and out of the page of Fig. 4) for each disc, then the placing step would have one alignment axis of one disc symmetrically placed with respect to another alignment axis of another disc, being non-collinear.

Regarding Claim(s) 6, in Kuroba if the alignment axis is drawn perpendicular to the disc surface for each disc, then each alignment axis would be collinear.

Regarding Claim(s) 9 Kuroba further teaches that an alignment axis can comprise of a first indicia and a second indicia (see col. 6, lines 65+), i.e. more than one reference mark 22, in which the second indicia is different from the first indicia because each are at different locations. One location of the first indicia would include a first line that is coextensive with the angular reference and a second line (taken from a second or different indicia) would be angularly

disposed from the first line of the first indicia. The first and second indicia of Kuroba can be said to be on different sides of the disc to the same extent that the applicant's first and second indicia are on different sides of the disc.

***Claim Rejections - 35 USC § 103***

**Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroba et al in view of Japanese Patent 5-205442 (referred to hereinafter as JP'442).**

Kuroba discloses the claimed manufacturing method as relied upon above in Claim 1. Kuroba does not mention that the indicia includes a laser index mark.

JP'442 teaches that an indicia (inner surface of discs) can include a laser index mark 12 to advantageously have quality information on the disc itself (see PURPOSE).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the indicia of Kuroda by including the laser index mark, as taught by JP'442, to positively provide quality information in the disc itself.

***Response to Arguments***

With respect to the 112, first and second paragraph rejections, the examiner arguments from the Final Rejection (mailed on February 24, 2010) and the Advisory Action (mailed on May 10, 2010) are maintained and fully incorporated by reference herein.

***Conclusion***

No art rejection has applied to Claims 21 through 24.

The applicant(s) amendment (**filed on November 2, 2009**) has necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 571-272-4570. The examiner can normally be reached on Monday - Friday 8:15 am - 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/A. Dexter Tugbang/  
Primary Examiner  
Art Unit 3729**

November 8, 2010